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Serial No. 09/112,020
December 29, 2003
Page 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES	<i>Application Number</i>	09/112,020
	<i>Filing Date</i>	July 8, 1998
	<i>First Named Inventor</i>	Katsuhiko AOKI
	<i>Group Art Unit</i>	2685
	<i>Examiner Name</i>	Quochien B. Vuong
	<i>Attorney Docket Number</i>	1945-104R
<i>Title of the Invention: MOBILE TERMINAL EQUIPMENT USABLE FOR BOTH SATELLITE AND TERRESTRIAL COMMUNICATION</i>		

**REQUEST FOR RECONSIDERATION OF NON-RESPONSIVENESS OF
AMENDMENT UNDER 37 CFR § 1.196(b)(1)**Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Reconsideration of the holding of Applicant's Rule 196(b) response filed September 11, 2003 as being non-responsive is requested. Claims 1-26 remain in this application.

The Examiner asserts that the Rule 196(b) filing is not fully responsive to the Board decision because Applicant amended claims 19 and 23 in addition to claim 1. This position is traversed.

First, pursuant to 37 CFR § 1.196(e), whenever a Board decision includes or allows a remand, that decision shall not be considered a final decision. The new ground of rejection in the Board's decision included and/or allowed a remand to the Examiner to evaluate the dependent claims based on the Board's application of the prior art to patented claim 1. See Board decision at 9. Pursuant to Rule 196(e), the Board's decision thus was not a final decision in that the rejection under Rule 196(b) was not limited to claim 1, but explicitly left evaluation of the other claims to the Examiner upon return of the application to the Examiner. Thus, the amendment under Rule 196(b)(1) properly addressed the other claims to which the new ground of rejection could be applied by the Examiner upon re-evaluation as directed by the Board.

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Karen R DeLuca

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FACSIMILE TRANSMITTAL SHEET

DATE: December 29, 2003
TO: Examiner Quochien B. Vuong
Art Unit 2685
FAX NO: 703-872-9306
FROM: Vincent M. DeLuca
RE: Serial No. 09/112,020
Our Ref: 1945-104R

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Number of Pages Including This Transmittal Sheet: 4

MESSAGE, IF ANY:

Serial No. 09/112,020

December 29, 2003

Page 2

Second, neither Rule 196(b)(1) nor MPEP 1214.01 precludes amendment of other claims in addition to amendment of claims newly rejected by the Board. Applicant did in fact submit an appropriate amendment of claim 1 and argument in support of patentability, as explicitly provided for in the rule. According to MPEP 1214.01 I., "[a]n amendment which adds new claims without either amending the rejected claims, or substituting new claims for the rejected claims, is not appropriate." Applicant did not add any new claims, and therefore the amendment is not inappropriate. MPEP 1214.01 does not state that an amendment of claims in addition to the claims newly rejected by the Board is not appropriate.

In fact, the MPEP explicitly states the new ground of rejection does not reopen prosecution except as to that subject matter to which the new rejection was applied. MPEP 1214.01 does not state that prosecution is not reopened except as to the claims to which the new rejection was applied, but instead as to the subject matter to which the new rejection was applied. Since claims 19 and 23 pertain to the same subject matter to which the new rejection was applied, the 196(b) amendment is appropriate.

The MPEP further explicitly acknowledges that "[p]rosecution before the examiner of the 37 CFR 1.196(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR 1.196(b) rejection."

In any event, as pointed out in the 196(b)(1) amendment, the basis of the Board's affirmance of the rejection of claims 19-26 was not the basis of the Examiner's final rejection, and thus, it is submitted that the Board's rejection of claims 19-26 also constitutes a new ground of rejection under 37 CFR 1.196(b). MPEP 1214.01 states that if the Board's decision in which the 196(b) rejection was made includes an affirmance of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. Here, as pointed out in the 196(b) amendment, the basis of the Examiner's rejection was not affirmed by the Board; instead, the Board resorted to a completely new basis for rejection – namely, modifying the Murata reference in a manner not taught or suggested by Murata, to achieve no recognizable purpose, and

Serial No. 09/112,020

December 29, 2003

Page 3

then applied the Board-modified Murata reference to the Wiedeman reference. Thus, it is submitted that the basis of the rejection of claims 19-26 should be open to further prosecution as a new ground of rejection, even though the Board's new basis for rejection was not specifically denominated a new ground of rejection in the Board's decision.

In conclusion, the Examiner is earnestly requested to enter the amendment filed on September 11, 2003. In the event the Examiner refuses to enter the amendment, Applicant requests that this paper be considered a Petition to the Commissioner under 37 CFR 1.181.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2135.

RESPECTFULLY SUBMITTED,					
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